



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/059,905 | 01/29/2002 | Gilad Odinak | WING-1-1007 | 7408 |

7590 07/14/2004

David A. Lowe, Esq.
BLACK LOWE & GRAHAM PLLC
816 Second Avenue
Seattle, WA 98104

EXAMINER

FOSTER, ROLAND G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2645

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/059,905

Applicant(s)

ODINAK ET AL.

Examiner

Roland G. Foster

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-67 is/are pending in the application.
- 4a) Of the above claim(s) 34-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

A detailed examination of the originally presented claims 1-33 was mailed on Nov. 18, 2003 as Paper No. 8. In response, the applicant filed an amendment on April 22, 2004 as Paper No. 10 that cancelled all originally presented claims 1-33 and then introduced new claims 34-67.

The newly presented claims are patently distinct. Specifically, the new claims appear to contain no (or at least very few) limitations in common with the originally presented claims, thus creating extensive and facially objective evidence of patentable distinctness.

In addition, administrative burden exists because the newly presented claims have different classifications, fields of search, and status in the art.

A restriction requirement under the above circumstances has several benefits. The restriction requirement promotes a clear and complete prosecution history of a single, original invention. The requirement also promotes the quality, administrative determination of patentability for both the applicant and for the public.

Therefore, the following restriction requirement will be set forth based upon election by original presentation. However, because the originally presented claims were cancelled and the newly amended claims are non-elected, no claims are presently available for examination. Therefore, the amendment will be considered non-responsive.

Election/Restrictions

Newly submitted claims 34-67 are directed to inventions that are independent or distinct from the originally presented inventions for claims 1-33 for the following reasons:

Description of the Separate Inventions

Restriction to one of the following inventions is required under 35 U.S.C. 121.

Invention I: originally presented claims 1-33, drawn to a system for processing user voice input based on two or more of noise cancellation, echo-cancellation, or end-pointing where speech recognition is performed on the processed user voice input.

Invention II: newly presented claims 34-67, drawn to a system for digital signal manipulation that converts an analog signal into noise cancelled digital signal in order to detect user speech by evaluating change in the amplitude sign of the digital signal. If user speech is detected, then the user speech is packaged into speech packets and a compatible transmission format is selected.

Classification and Field of Search

Invention I includes classification in class 704, subclass 248, speech recognition using end-point detection. Note also that Invention I could be classified in numerous other

Art Unit: 2645

class/subclasses relating to echo cancellation (e.g., class 379, subclasses 406+). The field of search for Invention I does not include the field of search for Invention II. For example, Invention I includes fields related to echo cancellation, end pointing, and speech recognition not present in Invention II.

Invention II includes classification in class 370, subclass 389, path finding or routing involving packet switching. Note also that Invention II could be classified in other subclasses such as those classes directed to the assembly/disassembly of packets (e.g., class 370, subclass 474) and those classes directed to digital signal processing and analysis of communication signals. The field of search for Invention II does not include the field of search for Invention I. For example, Invention II includes fields related to digital signal processing of a communication signal to evaluate changes in amplitude, packaging user speech into speech packets, and determining compatible transmission format not present in Invention I.

Separate Status in the Art

A separate field of search (as discussed above) also shows a separate status in the art (MPEP § 808.02).

The Separate Inventions are Subcombinations

Usable Together Having Separate Utility

Inventions I and II are related as subcombinations disclosed as usable together in a single system processing acoustical input.

The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility as system for performing speech recognition on processed, user speech. Invention II has separate utility as a system using specialized digital processing technique using amplitude changes to detect user speech, then packetizing the user's speech and determining a compatible transmission medium. See MPEP § 806.05(d).

Reasons for Requiring the Restriction

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for one Invention is not required for the other Inventions for the reasons given above, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter for the reasons given above, restriction for examination purposes as indicated is proper.

Art Unit: 2645

Constructive Election by Original Presentation

Since applicant has received an action on the merits for the originally presented Invention I (drawn to claims 1-33), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Invention II (drawn to claims 34-67) are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 819 and 821.03. However, the originally presented claims (constructively elected inventions) (claims 1-33) were cancelled by the amendment, filed on April 22, 2004 as Paper No. 10. Therefore, no claims are presently available for consideration.

Non-responsive Amendment

Because the amendment filed on April 22, 2004 as Paper No. 10 resulted in no claims available for consideration for the reasons given above, the amendment is not fully responsive to the prior Office Action. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Applicant is advised that the reply to this non-responsive amendment must be complete even if the requirement is traversed. A complete reply would include presenting claims available for consideration such as by filing an amendment canceling the non-elected, newly presented claims and re-introducing the originally presented claims (possibly in amended form). Applicant

Art Unit: 2645

may also file a divisional application in order to prosecute the invention recited in the non-elected, newly presented claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9309.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster
Primary Patent Examiner
July 12, 2004